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08/633,248
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07/07/99



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Anticipated Classification of this application:
 Class 436 Subclass 51000
 Prior application: 08/458,276
 Examiner: spiegel
 Art Unit: 1641

BOX PATENT APPLICATION
 Assistant Commissioner for Patents
 Washington, D. C. 20231

FILING UNDER 37 CFR § 1.53(B)

This is a request for filing for a

continuation divisional continuation-in-part (CIP)

application under 37 CFR § 1.53(b) of pending prior application Serial No. 08/633,248 filed on April 18, 1996, which names as inventors:

Kenneth F. Buechler and Paul H. McPherson

for: NOVEL METHODS FOR THE ASSAY OF TROPONIN I AND T AND COMPLEXES OF TROPONIN I AND T AND SELECTION OF ANTIBODIES FOR USE IN IMMUNOASSAYS

COPY OF PRIOR APPLICATION AS FILED WHICH IS ATTACHED

I hereby verify that the attached papers are a true and complete copy of what is shown in my records to be the above-identified prior application, including the oath or declaration as originally filed. (37 CFR § 1.53)

95 Page(s) of Specification

SD-108679.1

CERTIFICATE OF MAILING (37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

EL088592668US
 Express Mail Label No.

July 7, 1999
 Date of Deposit

Diana Neuner
 Name of Person Mailing Paper
Diana Neuner
 Signature of Person Mailing Paper

32 Page(s) of Claims
1 Page(s) of Abstract
10 Sheet(s) of Drawings formal informal
2 Page(s) of Declaration and Power of Attorney
1 Page(s) of Small Entity Statement

- Pursuant to 37 CFR 1.63(d)(1), a newly executed oath or declaration is not required.
- A newly executed oath or declaration is filed herewith.
- I hereby state that the amendment referred to in the declaration filed to complete the prior application, in accordance with the requirements of 37 CFR § 1.53(b), did not introduce new matter therein.

II. AMENDMENTS

- Cancel in this application original Claims 2-54 of the prior application before calculating the filing fee.
- A Preliminary Amendment is enclosed.

III. INFORMATION DISCLOSURE STATEMENT

- An Information Disclosure Statement, PTO 1449, and references are submitted herewith.

IV. PETITION FOR SUSPENSION OF PROSECUTION FOR THE TIME TO FILE AN AMENDMENT

- There is provided herewith a PETITION FOR SUSPENSION OF PROSECUTION FOR THE TIME NECESSARY TO FILE AN AMENDMENT (NEW APPLICATION FILED CONCURRENTLY).

V. FEE CALCULATION

BASIC FILING FEE:						\$760.00	
Total Claims	80	-	20	=	60	x \$18.00	\$1,080.00
Independent Claims	16	-	3	=	13	x \$78.00	\$1,014.00
Multiple Dependent Claims	\$260	(if applicable)			<input checked="" type="checkbox"/>	\$260.00	
Surcharge 37 CFR § 1.16(e)	\$130	(if applicable)			<input type="checkbox"/>	\$0.00	
TOTAL OF ABOVE CALCULATIONS						\$3,114.00	

Reduction by $\frac{1}{2}$ for Filing by Small Entity. Note 37 CFR §§ 1.9, 1.27,
1.28. If applicable, Verified Statement must be attached. \$1557.00

Misc. Filing Fees (Recordation of Assignment)	\$0.00
TOTAL FEES SUBMITTED HEREWITH	\$1,557.00

- The fee for extra claims is not being paid at this time.

VI. SMALL ENTITY STATUS

A Verified Statement to establish small entity under 37 CFR §§ 1.9 and 1.27:

- is attached
- has been filed in the prior application and such status is still proper and desired. [37 CFR § 1.28(a)]

VII. DRAWINGS

[NOTE: DO NOT CHECK THIS IF PRIOR CASE IS NOT TO BE ABANDONED.]

- Transfer the drawings from the prior application to this application and, subject to Item 16 below, abandon said prior application as of the filing date accorded to this application. A duplicate copy of this request is enclosed for filing in the prior application file.
[May only be used if signed by (1) applicant, (2) assignee of record or (3) attorney or agent of record and before payment of issue fee. 37 CFR § 1.138.]
- Transfer the following sheet(s) of drawings from the prior application to this application.
- New drawings are enclosed formal informal

VIII. PRIORITY - 35 USC § 119

- Priority of application Serial No. 08/633,248 filed on April 18, 1996, in USA, which is a continuation-in-part of U.S. Application Serial No. 08/423,582, filed April 18, 1995, which issued as U.S. Patent No. 5,795,725, is claimed under 35 USC § 119.
- The certified copy has been filed in prior U.S. application Serial No. _____ on _____.
- The certified copy will follow.

IX. RELATE BACK - 35 USC § 120

- Amend the Specification by inserting before the first line the sentence:
This is a continuation of co-pending application Serial No. _____ filed _____, which will issue as U.S. Patent No. on.

X. INVENTORSHIP STATEMENT

- With respect to the prior co-pending U.S. application from which this application claims benefit under 35 USC § 120, the inventor(s) in this application is (are):
- the same
- less than those named in the prior application and it is requested that the following inventor(s) identified above for the prior application be deleted:
- The inventorship for all the claims in this application are:
- the same.
- not the same, and an explanation, including the ownership of the various claims at the time the last claimed invention was made, is submitted.

XI. ASSIGNMENT

- The prior application is assigned of record to Biosite Diagnostics, Inc..
- An Assignment of the invention to _____ is attached.

XII. FEE PAYMENT BEING MADE AT THIS TIME

- Not attached. No filing fee is submitted. [This and the surcharge required by 37 CFR § 1.16(e) can be paid subsequently.]
- Attached.
- | | |
|--|----------------|
| <input checked="" type="checkbox"/> Filing fees. | <u>\$1,557</u> |
| <input type="checkbox"/> Recording assignment. [\$40.00 37 CFR § 1.21(h)(1)] | — |
| Petition fee for filing by other than all the inventors or person on behalf of the inventor where inventor refused to sign or cannot be reached. | |
| [\$130.00; 37 CFR §§ 1.47 and 1.17(h)] | |
| <input type="checkbox"/> Petition fee to Suspend Prosecution for the Time Necessary to File an Amendment (New Application Filed Concurrently.) | — |
| [\$130.00; 37 CFR §§ 1.103 and 1.17(i)] | |

- For processing an application with a specification in a non-English language.
[\$130.00; 37 CFR §§ 1.52(d) and 1.17(k)]
- Processing and retention fee.
[\$130.00; 37 CFR §§ 1.53(f) and 1.21(l)]

Total Fees Enclosed \$1,557

XIII. METHOD OF PAYMENT OF FEES

- Attached is a check in the amount of \$1,557.00.
- Charge Deposit Account No. **12-2475** in the amount of _____.

XIV. AUTHORIZATION TO CHARGE ADDITIONAL FEES

The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Deposit Account No. **12-2475**:

- 37 CFR § 1.16(a) (filing fees).
- 37 CFR § 1.16(b) (presentation of extra claims).
- 37 CFR § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application).
- 37 CFR § 1.17 (application processing fees).
- 37 CFR § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 CFR § 1.311(b)).

XV. INSTRUCTIONS AS TO OVERPAYMENT

- Credit Deposit Account No. **12-2475**.
- Refund

XVI. POWER OF ATTORNEY

- The power of attorney in the prior application is to _____.
- The power of attorney in the prior application is to the registered attorneys listed below and members of or associates in the law firm of **LYON & LYON LLP**, 633 West Fifth Street, 47th Floor, Los Angeles, California 90071, Registration No. 11,611, whose members are registered to practice in the U.S. Patent and Trademark office:

Roland N. Smoot, Reg. No. 18,718
 Conrad R. Solum, Jr., Reg. No. 20,467
 James W. Geriak, Reg. No. 20,233
 Robert M. Taylor, Jr., Reg. No. 19,848
 Samuel B. Stone, Reg. No. 19,297
 Douglas E. Olson, Reg. No. 22,798
 Robert E. Lyon, Reg. No. 24,171
 Robert C. Weiss, Reg. No. 24,939
 Richard E. Lyon, Jr., Reg. No. 26,300
 John D. McConaghy, Reg. No. 26,733
 William C. Steffin, Reg. No. 26,811
 Coe A. Bloomberg, Reg. No. 26,605
 J. Donald McCarthy, Reg. No. 25,119
 John M. Benassi, Reg. No. 27,483
 James J. Shalek, Reg. No. 29,749
 Allan W. Jansen, Reg. No. 29,035
 Robert W. Dickerson, Reg. No. 29,914
 Roy L. Anderson, Reg. No. 30,240
 David B. Murphy, Reg. No. 31,125

James C. Brooks, Reg. No. 29,898
 Jeffrey M. Olson, Reg. No. 30,790
 Steven D. Hemminger, Reg. No. 30,755
 Jerrold B. Reilly, Reg. No. 32,293
 Paul H. Meier, Reg. No. 32,274
 John A. Rafter, Jr., Reg. No. 31,653
 Kenneth H. Ohriner, Reg. No. 31,646
 Mary S. Consalvi, Reg. No. 32,212
 Lois M. Kwasigroch, Reg. No. 35,579
 Lawrence R. LaPorte, Reg. No. 38,948
 Robert C. Laurenson, Reg. No. 34,206
 Carol A. Schneider, Reg. No. 34,923
 Hope E. Melville, Reg. No. 34,874
 Michael J. Wise, Reg. No. 34,047
 Richard J. Warburg, Reg. No. 32,327
 Kurt T. Mulville, Reg. No. 37,194
 Theodore S. Maceiko, Reg. No. 35,593
 Bruce G. Chapman, Reg. No. 33,846
 F. T. Alexandra Mahaney, Reg. No. 37,668

- The power appears in the original papers in the prior application.
- The power does not appear in the original papers, but was filed on July 10, 1996, in this application.
- A new power has been executed and is attached.
- Address all future communications to:

LYON & LYON LLP
 633 West Fifth Street, 47th Floor
 Los Angeles, California 90071-2066
 (213) 489-1600

XVII. MAINTENANCE OF CO-PENDENCY OF PRIOR APPLICATION

- A petition, fee and response has been filed to extend the term in the pending **prior** application until _____. A copy of the petition for extension of time in the **prior** application is attached.

XVIII. CONDITIONAL PETITIONS FOR EXTENSION OF TIME IN PRIOR APPLICATION

- A conditional petition for extension of time is being filed in the pending **prior** application. A copy of the conditional petition for extension of time in the **prior** application is attached.

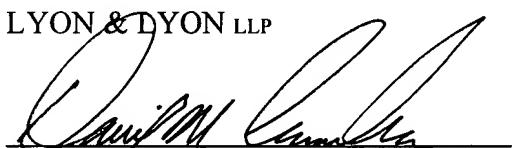
XIX. ABANDONMENT OF PRIOR APPLICATION

- Please abandon the prior application at a time while the prior application is pending or when the petition for extension of time or to revive in that application is granted and when this application is granted a filing date so as to make this application co-pending with said prior application. At the same time, please add the words "now abandoned" to the amendment of the specification set forth in Item 2 above.

Respectfully submitted,

LYON & LYON LLP

By:


For Richard J. Warburg,
Daniel M. Chambers
Registration No. 34,561

Dated: 07/07/99

633 West Fifth Street, Suite 4700
Los Angeles, California 90071-2066
(213) 489-1600

Enclosures

Biosite Diagnostics, Inc.

Name of Assignee

11030 Roselle Street, Suite D, San Diego, CA 92121

Address of Assignee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

**Kenneth F. Buechler and Paul H.
McPherson**

Serial No.: Not Yet Assigned

Filed: Herewith

For: NOVEL METHODS FOR THE
ASSAY OF TROPONIN I AND T
AND COMPLEXES OF TROPONIN I
AND T AND SELECTION OF
ANTIBODIES FOR USE IN
IMMUNOASSAYS

Group Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

TRANSMITTAL LETTERAssistant Commissioner for Patents
Washington, D.C. 20231
Box Patent Application

Sir:

Transmitted herewith for filing in the above-referenced application are the

following:

SD-121583.1

CERTIFICATE OF MAILING
(37 C.F.R. §1.10)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as 'Express Mail Post Office To Addressee' in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.
EL088592668US

Express Mail Label No.

July 7, 1999

Date of Deposit

Diana Neuner
Name of Person Mailing Paper
Diana Neuner
Signature of Person Mailing Paper

Patent

- Patent Application Under 37 C.F.R. § 1.53(B), consisting of:

- 95 Pages of Specification;
- 32 Pages of Claims;
- 10 Sheets of Drawings;
- 2 Pages of Declaration and Power of Attorney; and
- 1 Page of Small Entity Statement;
- Preliminary Amendment;
- Check in the amount of \$1557; and
- Return postcard.

The enclosed check includes \$1557 for the filing fee for the Patent Application Under 37 C.F.R. § 1.53(B). If the enclosed fee is incorrect, please charge or credit our Deposit Account No. 12-2475 for the appropriate amount.

Respectfully submitted,

LYON & LYON LLP

Dated 07/07/99

By 

For Richard J. Warburg,
Daniel M. Chambers
Registration No. 34,561

First Interstate World Center
633 West Fifth Street, 47th Floor
Los Angeles, CA 90071-2066
Telephone: (619) 552-8400
Facsimile: (213) 955-0440